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Akseli Anttila

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EXAMINER

UBER, NATHAN C

ART UNIT

PAPER NUMBER

3622

NOTIFICATION DATE

DELIVERY MODE

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ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|                              |                                      |                                       |  |
|------------------------------|--------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/518,686 | <b>Applicant(s)</b><br>ANTTILA ET AL. |  |
|                              | <b>Examiner</b><br>NATHAN C. UBER    | <b>Art Unit</b><br>3622               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 27-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>19 July 2010</u>  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the RCE filed on 26 March 2010.
2. Claims 1, 16, 19, 22, 23 and 27-32 have been amended.
3. Claims 1-23 and 27-32 are currently pending and have been examined.

### **Continued Examination Under 37 CFR 1.114**

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 March 2010 has been entered.

### **Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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7. Claims 1-18 and 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strietzel (U.S. 2001/0051517) in view of Treyz (U.S. 6,587,835 B1).

**Claim 1:**

Strietzel, as shown, discloses the following limitation:

- *a promotion server configured to receive a promotion message request from an event manager* (see at least ¶0034, line third party advertisers may pay the telecomm provider to provide ads to telecomm customers; advertisement messages are stored in the advertisement database, the database is part of the network subsystem),
- *said promotion server configured to cause, at least in part, sending of said promotion message including said invitation to one or more communications terminal through at least one communication network* (see at least ¶0042, advertisements are routed to the user terminal),
- *said promotion server further configured to generate a promotion message comprising an invitation to be reminded prior to a start of an event scheduled to start at a defined start time based on said promotion message request* (see at least ¶0042, advertisements are routed to the user terminal),

The Strietzel invention does not specifically disclose the composition of the *promotion message*. The content of a promotion message does not patentably affect the scope of the invention and therefore carries no patentable weight in the claim. As claimed the server is configured to generate and send the promotion message. The composition of the promotion message being an invitation to be reminded of a start time of an event is merely non-functional data in the claim. The composition of the promotion message can vary with out affecting the scope of the claim. Despite the content of the message being non-functional descriptive material, such content, an invitation to request an event reminder, is at least taught by Treyz (see at least column 35, lines 54-67). Treyz discloses a shopper-assisting device based on any handheld computing device including

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cell phones, pdas and laptops (see column 9, lines 56-67). Treyz explains one feature in which events are promoted to the user of the handheld device, the user may select to be reminded of the event, and before the event occurs the device reminds the user of the event. Examiner notes that Treyz indicates that the reminder may be stored locally in the user device or remotely requiring the reminder to be "sent" at the appropriate time. Since both the Strietzel and Treyz inventions concern sending promotions to a user via networks to hand held communication devices, it would have been obvious to one having ordinary skill in the art at the time of the invention to integrate some or all of the communication features (i.e. promoting events and setting reminders) taught by the Treyz disclosure with the invention of Strietzel since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. Particularly, both inventions are focused on using any communications means to target appropriate messages to a user.

Further, Strietzel, as shown, discloses the following limitations:

- *said promotion server further being configured to receive an acceptance signal relating to the sent promotion message from one or more communication terminals through said at least one communication network (see at least ¶0055, "[in]...a cellular network, or a paging network can stay on after the communication transaction is over and receive options or a menu allowing the party to select to receive more information about a particular product or service... the user can actually select to be connected directly to the company offering the products or service"),*
- *said promotion server comprising a register for associating an accepting communication terminal of said one or more communication terminals with said promotion message, on reception of said acceptance signal from said*

*accepting communication terminal*, (see at least ¶0042, "...processing means selectively associates at least one advertisement with the source and/or destination of the communication based on the information determined," "an advertisement may be associated with the destination terminal;" see also at least ¶0059),

- *said promotion server further being configured to cause, at least in part, sending of a reminder signal for said event to said accepting communication terminal based on said defined start time included in said promotional message through said first communication network* (see at least ¶0007, "[t]he telecommunications advertising means comprises an advertisement database and a processing means" for sending promotional messages; see also at least ¶¶0036-0037, targeted advertising including ads sent based on time, location, language etcetera; see also at least the Treyz reference at the citations noted above),
- *wherein said event manager is separate from the one or more communication terminals* (Examiner interprets the event manager broadly, based on the page 14, lines 26-28 of the specification, to be a person that promotes events, see at least ¶0042, source and destination are different entities; see also at least ¶0034, businesses and third party advertisers).

**Claim 2:**

The combination Strietzel/Treyz discloses the limitations as shown in the rejection above.

Further, Strietzel, as shown, discloses the following limitation:

- *said one or more communication terminals comprise at least one of mobile phones, cellular phones, personal office assistants or personal computers* (see at least ¶0056, "[t]he device could be, for example, a telephone, cellphone, PDA, or computer...").

**Claim 3:**

The combination Strietzel/Treyz discloses the limitations as shown in the rejection above.

Further, Strietzel, as shown, discloses the following limitation:

- *said promotion message comprises at least one of a text, a series of texts, a picture, a series of pictures, a video sequence, a series of video sequences, an audio track or a series of audio tracks (see at least ¶0038, “the advertisement may be an audio advertisement, it may be a jingle, a textual message, a video message, a graphic message, or a combination of these messages depending on the desired implementation”).*

**Claim 4:**

The combination Strietzel/Treyz discloses the limitations as shown in the rejection above.

Further, Strietzel, as shown, discloses the following limitation:

- *said one or more receivers comprise at least one of a television, a radio, a set-top box, a receiver module for a computer, a multimedia terminal, a mobile or cellular phone, a personal office assistant or a personal computer (see at least ¶0056, “[t]he device could be, for example, a telephone, cellphone, PDA, or computer...”).*

**Claim 5:**

The combination Strietzel/Treyz discloses the limitations as shown in the rejection above.

Further, Strietzel, as shown, discloses the following limitation:

- *said promotion message request comprises at least one of start time, end time of said event, duration of said event, event identity, event type, event presentation platform, promotion message or list of said receivers and said one or more communication terminals (see at least ¶0042, “...processing means selectively associates at least one advertisement with the source and/or destination of the communication based on...” “...destination, type of communication, time of day, etc...”).*

**Claim 6:**

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The combination Strietzel/Treyz discloses the limitations as shown in the rejection above.

Further, Strietzel, as shown, discloses the following limitation:

- *said event presentation platform comprises at least one of the following connected to a media communication network and a network broadcaster: television, a radio, a set-top box, a receiver module for a computer, a multimedia terminal, a mobile or cellular phone, a personal office assistant or a personal computer (see at least ¶0056, "[t]he device could be, for example, a telephone, cellphone, PDA, or computer...").*

**Claim 7:**

The combination Strietzel/Treyz discloses the limitations as shown in the rejection above.

Further, Strietzel, as shown, discloses the following limitation:

- *said media communication network comprises at least one of a cable television network, a satellite television network, a radio frequency television network, a telephone network, a powerline network, or a radio network see at least ¶0056, "[t]he device could be, for example, a telephone, cellphone, PDA, or computer...").*

**Claim 8:**

The combination Strietzel/Treyz discloses the limitations as shown in the rejection above.

Further, Strietzel, as shown, discloses the following limitation:

- *said first communication network comprises at least one of a wired telecommunication network, a wireless telecommunication network, local area network, metropolitan area network, wide area network, or inter-network such as the Internet or a dedicated communication line (see at least ¶0025, fixed telecommunications network).*

**Claim 9:**

The combination Strietzel/Treyz discloses the limitations as shown in the rejection above.

Further, Strietzel, as shown, discloses the following limitation:



- *said connection comprises at least one of wired telecommunication network, a wireless telecommunication network, local area network, metropolitan area network, wide area network or a dedicated communication line (see at least ¶0025, fixed telecommunications network).*

**Claim 10:**

The combination Strietzel/Treyz discloses the limitations as shown in the rejection above.

Further, Strietzel, as shown, discloses the following limitations:

- *a storage device configured to store said register, said reminder and said promotion message (see at least ¶0021, “[a]dvertisement database stores advertisements that can be played),*
- *a processor configured to process communication with said one or more communication terminals, configured to process said promotion message request from said event manager, and to update information in said storage device (see at least ¶0042, “...processing means selectively associates at least one advertisement with the source and/or destination of the communication based on the information determined”).*

**Claim 11:**

The combination Strietzel/Treyz discloses the limitations as shown in the rejection above.

Further, Strietzel, as shown, discloses the following limitations:

- *said register comprises at least one of promotion message identity (see at least ¶0021, “[a]dvertisement database stores advertisements that can be played to system users at appropriate times based on appropriate criteria”),*
- *one or more communication terminal identities (see at least ¶0021, “[a]dvertisement database stores advertisements that can be played to system users at appropriate times based on appropriate criteria”),*

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- *event data* (see at least ¶0021, “[a]dvertisement database stores advertisements that can be played to system users at appropriate times based on appropriate criteria”),
- *time data or* (see at least ¶0021, “[a]dvertisement database stores advertisements that can be played to system users at appropriate times based on appropriate criteria”),
- *group application data* (see at least ¶0021, “[a]dvertisement database stores advertisements that can be played to system users at appropriate times based on appropriate criteria”).

**Claim 12:**

The combination Strietzel/Treyz discloses the limitations as shown in the rejection above.

Further, Strietzel, as shown, discloses the following limitation:

- *said one or more communication terminals is configured to forward said promotion message to further communication terminals connected in said first communication network* (see at least ¶0081, “[i]n one embodiment, advertisements received on a terminal can be forwarded to all or some of the stored phone numbers”).

**Claim 13:**

The combination Strietzel/Treyz discloses the limitations as shown in the rejection above.

Further, Strietzel, as shown, discloses the following limitations:

- *wherein an accepting communication terminal of said further communication terminals is configured to respond to said promotion message by communicating an acceptance signal through said first communication network to said promotion server* (see at least ¶0055, “[in]...a cellular network, or a paging network can stay on after the communication transaction is over and receive options or a menu allowing the party to select to receive more information about a particular product or service... the user

can actually select to be connected directly to the company offering the products or service”),

- *said promotion server is further configured to associate said accepting communication terminal of said further communication terminals with said promotion message on reception of said acceptance signal from said accepting communication terminal (see at least ¶0042, “...processing means selectively associates at least one advertisement with the source and/or destination of the communication based on the information determined”),*
- *said promotion server being adapted to communicate a reminder signal to said accepting communication terminal through said first communication network (see at least ¶0007, “[t]he telecommunications advertising means comprises an advertisement database and a processing means”).*

**Claim 14:**

The combination Strietzel/Treyz discloses the limitations as shown in the rejection above.

Further, Strietzel, as shown, discloses the following limitations:

- *an accepting communication terminal of said further communication terminals is configured to respond to said promotion message by communicating an acceptance signal through said first communication network to said one or more communication terminals (see at least ¶0055, “[in]...a cellular network, or a paging network can stay on after the communication transaction is over and receive options or a menu allowing the party to select to receive more information about a particular product or service... the user can actually select to be connected directly to the company offering the products or service”),*
- *said one or more communication terminal further comprising a local register configured to associate an accepting communication terminal of said further communication terminals with said promotion message on reception of said*

*acceptance signal from said accepting communication terminal (see at least ¶0042, "...processing means selectively associates at least one advertisement with the source and/or destination of the communication based on the information determined"),*

- *said one or more communication terminals being configured to communicate a reminder signal to said accepting communication terminal through said first communication network (see at least ¶0007, "[t]he telecommunications advertising means comprises an advertisement database and a processing means").*

**Claim 15:**

The combination Strietzel/Treyz discloses the limitations as shown in the rejection above.

Further, Strietzel, as shown, discloses the following limitation:

- *said one or more communication terminals are configured to start a predetermined application when receiving said reminder signal (see at least ¶0038, "the advertisement may be an audio advertisement, it may be a jingle, a textual message, a video message, a graphic message, or a combination of these messages depending on the desired implementation").*

**Claims 16, 29, 31 and 32:**

Strietzel, as shown, discloses the following limitations:

- *receiving a promotion message request from an event manager (see at least ¶0034, line third party advertisers may pay the telecomm provider to provide ads to telecomm customers; advertisement messages are stored in the advertisement database, the database is part of the network subsystem),*
- *generating a promotion message comprising an invitation to be reminded prior to a start of an event scheduled to start at a defined start time based on said promotion message request (see at least ¶0042, advertisements are routed to the user terminal),*

- *causing, at least in part, sending by said promotion server, of said promotion message including said invitation to one or more communication terminals via said promotion server connected to said one or more communication terminals through a first communication network (see at least ¶0007, “[t]he telecommunications advertising means comprises an advertisement database and a processing means;” see also at least ¶0042, advertisements are routed to the user terminal),*
- *initiating at a promotion server a promotion message via an event manager (see at least ¶0007, “[t]he telecommunications advertising means comprises an advertisement database and a processing means,” the Strietzel disclosure further includes numerous triggering events that initiate the processing means),*
- *forwarding a promotion message request to said promotion server (see at least ¶0007, “[t]he telecommunications advertising means comprises an advertisement database and a processing means,” the Strietzel disclosure further includes numerous triggering events that initiate the processing means),*
- *receiving at said promotion server an acceptance signal relating to the sent promotion message from an accepting communication terminal of said one or more communication terminals via said promotion server (see at least ¶0042, “...processing means selectively associates at least one advertisement with the source and/or destination of the communication based on the information determined”, acceptance signal is broadly interpreted here to mean a signal that a communication line is established (i.e. signal received), as shown in the cited paragraph once communication is established the promotion server determines which advertisement to route to the users devices and how best to route it, see also ¶0061, users are able to respond to a received*

advertisement, this response signal is received by the system and the user is connected to the advertiser),

- *associating by said promotion server said accepting communication terminal with said promotion message on reception of said acceptance signal from said accepting communication terminal via a register of said promotion server* (see at least ¶0042, "...processing means selectively associates at least one advertisement with the source and/or destination of the communication based on the information determined", *acceptance signal* is broadly interpreted here to mean a signal that a communication line is established (i.e. signal received), as shown in the cited paragraph once communication is established the promotion server determines which advertisement to route to the users devices and how best to route it, see also ¶0061, users are able to respond to a received advertisement, this response signal is received by the system and the user is connected to the advertiser),
- *causing, at least in part, sending of a reminder for said event to said accepting communication terminal based on said defined start time included in said promotional message through said first communication network via said promotion server* (see at least ¶0007, "[t]he telecommunications advertising means comprises an advertisement database and a processing means," see also at least ¶0065 "[t]he user may even be able to select that more information or similar advertisement sources be provided;" Examiner notes that patentable weight was not given to the "reminder signal" because examiner identified prior art capable of sending signals to terminals and the content of the signals does not affect the scope of the claims, examiner also notes that weight was not given to the "signal" only the action of transmitting a signal),

- *wherein said event manager is separate from the one or more communication terminals* (Examiner interprets the event manager broadly, based on the page 14, lines 26-28 of the specification, to be a person that promotes events, see at least ¶0042, source and destination are different entities).

The Strietzel invention does not specifically disclose the composition of the *promotion message*. The content of a promotion message does not patentably affect the scope of the invention and therefore carries no patentable weight in the claim. As claimed the server is configured to generate and send the promotion message. The composition of the promotion message being an invitation to be reminded of a start time of an event is merely non-functional data in the claim. The composition of the promotion message can vary with out affecting the scope of the claim. Despite the content of the message being non-functional descriptive material, such content, an invitation to request an event reminder, is at least taught by Treyz (see at least column 35, lines 54-67). Treyz discloses a shopper-assisting device based on any handheld computing device including cell phones, pdas and laptops (see column 9, lines 56-67). Treyz explains one feature in which events are promoted to the user of the handheld device, the user may select to be reminded of the event, and before the event occurs the device reminds the user of the event. Examiner notes that Treyz indicates that the reminder may be stored locally in the user device or remotely requiring the reminder to be "sent" at the appropriate time. Since both the Strietzel and Treyz inventions concern sending promotions to a user via networks to hand held communication devices, it would have been obvious to one having ordinary skill in the art at the time of the invention to integrate some or all of the communication features (i.e. promoting events and setting reminders) taught by the Treyz disclosure with the invention of Strietzel since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would

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have recognized that the results of the combination were predictable. Particularly, both inventions are focused on using any communications means to target appropriate messages to a user.

Examiner further notes with regard to claim 32 directed to an "apparatus," "[w]hile features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original)" (MPEP §2114). Here Applicant has claimed an apparatus, but failed to limit or differentiate the claimed structure from any apparatus comprising a processor and a memory.

**Claim 17:**

The combination Strietzel/Treyz discloses the limitations as shown in the rejection above. Further, Strietzel, as shown, discloses the following limitations:

- *causing, at least in part, forwarding said promotion message to further communication terminals via said one or more communication terminals (see at least ¶0081, "[i]n one embodiment, advertisements received on a terminal can be forwarded to all or some of the stored phone numbers").*

**Claim 18:**

The combination Strietzel/Treyz discloses the limitations as shown in the rejection above. Further, Strietzel, as shown, discloses the following limitations:



- *causing, at least in part, accepting said promotion message by causing, at least in part, transmission an acceptance signal to said one or more communication terminals via said further communication terminals (see at least ¶0042, "...processing means selectively associates at least one advertisement with the source and/or destination of the communication based on the information determined", acceptance signal is broadly interpreted here to mean a signal that a communication line is established (i.e. signal received), as shown in the cited paragraph once communication is established the promotion server determines which advertisement to route to the users devices and how best to route it, see also ¶0061, users are able to respond to a received advertisement, this response signal is received by the system and the user is connected to the advertiser),*
- *receiving said acceptance signal from an accepting communication terminal of said further communication terminals via said one or more communication terminals (see at least ¶0042, "...processing means selectively associates at least one advertisement with the source and/or destination of the communication based on the information determined", acceptance signal is broadly interpreted here to mean a signal that a communication line is established (i.e. signal received), as shown in the cited paragraph once communication is established the promotion server determines which advertisement to route to the users devices and how best to route it, see also ¶0061, users are able to respond to a received advertisement, this response signal is received by the system and the user is connected to the advertiser),*
- *associating said accepting communication terminal with said promotion message on reception of said acceptance signal from said accepting communication terminal via a local register of said one or more communication terminal (see at least ¶0042, "...processing means*

selectively associates at least one advertisement with the source and/or destination of the communication based on the information determined”, acceptance signal is broadly interpreted here to mean a signal that a communication line is established (i.e. signal received), as shown in the cited paragraph once communication is established the promotion server determines which advertisement to route to the users devices and how best to route it, see also ¶0061, users are able to respond to a received advertisement, this response signal is received by the system and the user is connected to the advertiser),

- *causing, at least in part, transmission of a reminder signal for said event to said accepting communication terminal through said first communication network by means of said one or more communication terminal (see at least ¶0007, “[t]he telecommunications advertising means comprises an advertisement database and a processing means,” see also at least ¶0065 “[t]he user may even be able to select that more information or similar advertisement sources be provided;” Examiner notes that patentable weight was not given to the “reminder signal” because examiner identified prior art capable of sending signals to terminals and the content of the signals does not affect the scope of the claims, examiner also notes that weight was not given to the “signal” only the action of transmitting a signal).*

**Claim 19:**

Strietzel, as shown, discloses the following limitations:

- *at least one processor (see at least ¶0007, “a processing means”),*
- *at least one memory including computer program code, the at least one memory and the computer program code configured to, with the at least one processor, cause the apparatus to perform at least the following, receive, from a promotion server, a promotional message including an invitation to be*

*reminded prior to a start of an event scheduled to start at a defined start time through a first communication network* (see at least Figure 1, 106 Router; see also at least ¶0042, advertisements are routed to the user terminal),

The Strietzel invention does not specifically disclose the composition of the *promotion message*. The content of a promotion message does not patentably affect the scope of the invention and therefore carries no patentable weight in the claim. As claimed the server is configured to generate and send the promotion message. The composition of the promotion message being an invitation to be reminded of a start time of an event is merely non-functional data in the claim. The composition of the promotion message can vary with out affecting the scope of the claim. Despite the content of the message being non-functional descriptive material, such content, an invitation to request an event reminder, is at least taught by Treyz (see at least column 35, lines 54-67). Treyz discloses a shopper-assisting device based on any handheld computing device including cell phones, pdas and laptops (see column 9, lines 56-67). Treyz explains one feature in which events are promoted to the user of the handheld device, the user may select to be reminded of the event, and before the event occurs the device reminds the user of the event. Examiner notes that Treyz indicates that the reminder may be stored locally in the user device or remotely requiring the reminder to be "sent" at the appropriate time. Since both the Strietzel and Treyz inventions concern sending promotions to a user via networks to hand held communication devices, it would have been obvious to one having ordinary skill in the art at the time of the invention to integrate some or all of the communication features (i.e. promoting events and setting reminders) taught by the Treyz disclosure with the invention of Strietzel since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. Particularly, both

inventions are focused on using any communications means to target appropriate messages to a user.

- *enable a user of said apparatus terminal to perform general calendar operations* (see at least Figure 1, 102 Message Database) based on Applicant's definition of *calendar operations*, see 35 U.S.C. 112 rejections above, it would have been obvious to one of ordinary skill in the art at the time of the invention to include additional data such as *calendar operations* within the message database because this will provide a central location for all data pertaining to advertisements and thus faster access to necessary data and improved functionality,
- *output playback of said promotion message* (see at least Figure 1, 106 Router),
- *store promotion message information* (see at least Figure 1, 102 Message Database),
- *transmit said promotion message* (see at least Figure 1, 106 Router),
- *cause, at least in part, transmission of an acceptance message for said invitation to said promotion server* (see at least ¶0042, indicating acceptance and sending the signal to the promotion server),
- *receive a reminder signal for said event based on the defined start time included in said promotional message* (see at least ¶0007, "[t]he telecommunications advertising means comprises an advertisement database and a processing means," see also at least ¶0065 "[t]he user may even be able to select that more information or similar advertisement sources be provided;" Examiner notes that patentable weight was not given to the "reminder signal" because examiner identified prior art capable of sending signals to terminals and the content of the signals does not affect the scope

of the claims, examiner also notes that weight was not given to the “signal” only the action of transmitting a signal),

- *output playback of said reminder signal* (see at least ¶0038, “the advertisement may be an audio advertisement, it may be a jingle, a textual message, a video message, a graphic message, or a combination of these messages depending on the desired implementation”).

Examiner further notes with regard to claim 19 directed to an “apparatus,” “[w]hile features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board’s finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original)” (MPEP §2114). Here Applicant has claimed an apparatus, but failed to limit or differentiate the claimed structure from any apparatus comprising a processor and a memory.

**Claim 20:**

The combination Strietzel/Treyz discloses the limitations as shown in the rejection above.

Further, Strietzel, as shown, discloses the following limitations:

- *wherein said promotion message information comprises at least one of promotion message identity, one or more communication terminal identities, event data or group application data* (see at least ¶0021, “[a]dvertisement database stores advertisements that can be played to system users at appropriate times based on appropriate criteria”).

**Claim 21:**

The combination Strietzel/Treyz discloses the limitations as shown in the rejection above.

Further, Strietzel, as shown, discloses the following limitations:

- *audio and visual components configured to communicate the promotion message to the user of the apparatus* (see at least ¶0038, “the advertisement may be an audio advertisement, it may be a jingle, a textual message, a video message, a graphic message, or a combination of these messages depending on the desired implementation” and see at least ¶0056, “[t]he device could be, for example, a telephone, a cellphone, PDA, or computer...”). Although Strietzel does not specifically require or disclose a audio and visual components, Strietzel contemplates such devices being present in a given receiver depending on the receiver and the supporting network.

**Claim 22:**

The combination Strietzel/Treyz discloses the limitations as shown in the rejection above.

Further, Strietzel, as shown, discloses the following limitations:

- *store a promotion message and identity information comprising transmitter identity and associated messaging contact information, recipient identity and associated messaging contact information, media event information and group application data* (see at least Figure 1, 102 Message Database),
- *which data is configured to initialize and activate a reminder application in response to receiving said reminder signal on said apparatus* (see at least Figure 1, Item 104 Processing Means).

**Claim 23:**

The combination Strietzel/Treyz discloses the limitations as shown in the rejection above.

Further, Treyz, as shown, discloses the following limitation:

- *utilize an electronic program guide containing information on media events, and provide a reject signal when said apparatus is busy (see at least column 35, line 54, a calendar of upcoming events),*

Since both the Strietzel and Treyz inventions concern sending promotions to a user via networks to hand held communication devices, it would have been obvious to one having ordinary skill in the art at the time of the invention to integrate some or all of the communication features (i.e. promoting events and setting reminders) taught by the Treyz disclosure with the invention of Strietzel since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. Particularly, both inventions are focused on using any communications means to target appropriate messages to a user.

**Claim 27:**

Streitzel, as shown, discloses the following limitation:

- *at least one processor (see at least ¶0007, "a processing means"),*
- *at least one memory including computer program code, the at least one memory and the computer program code configured to, with the at least one processor, cause the apparatus to perform at least the following receive a promotion message from a promotion server, the promotion message including an invitation to be reminded prior to a start of an event scheduled to start at a defined start time based on said promotion message request (see at least ¶0056, "[t]he device could be, for example, a telephone, a cellphone, PDA, or computer..."; see also at least ¶0042, advertisements are routed to the user terminal),*

The Strietzel invention does not specifically disclose the composition of the *promotion message*. The content of a promotion message does not patentably affect the scope of

the invention and therefore carries no patentable weight in the claim. As claimed the server is configured to generate and send the promotion message. The composition of the promotion message being an invitation to be reminded of a start time of an event is merely non-functional data in the claim. The composition of the promotion message can vary with out affecting the scope of the claim. Despite the content of the message being non-functional descriptive material, such content, an invitation to request an event reminder, is at least taught by Treyz (see at least column 35, lines 54-67). Treyz discloses a shopper-assisting device based on any handheld computing device including cell phones, pdas and laptops (see column 9, lines 56-67). Treyz explains one feature in which events are promoted to the user of the handheld device, the user may select to be reminded of the event, and before the event occurs the device reminds the user of the event. Examiner notes that Treyz indicates that the reminder may be stored locally in the user device or remotely requiring the reminder to be "sent" at the appropriate time. Since both the Strietzel and Treyz inventions concern sending promotions to a user via networks to hand held communication devices, it would have been obvious to one having ordinary skill in the art at the time of the invention to integrate some or all of the communication features (i.e. promoting events and setting reminders) taught by the Treyz disclosure with the invention of Strietzel since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. Particularly, both inventions are focused on using any communications means to target appropriate messages to a user.

Further, Streitzel, as shown, discloses the following limitations:

- *cause, at least in part, transmission of an acceptance signal for said invitation based on information in at least one of a calendar or a list of*



*scheduled events residing in the apparatus* (see at least ¶0056, “[t]he device could be, for example, a telephone, a cellphone, PDA, or computer...”),

- *receive a reminder signal from said promotion server based on said defined start time included in said promotional message* (see at least ¶0056, “[t]he device could be, for example, a telephone, a cellphone, PDA, or computer...”)
- *output playback of said reminder signal* (see at least ¶0038, “the advertisement may be an audio advertisement, it may be a jingle, a textual message, a video message, a graphic message, or a combination of these messages depending on the desired implementation”).

Examiner further notes with regard to claim 27 directed to an “apparatus,” “[w]hile features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board’s finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original)” (MPEP §2114). Here Applicant has claimed an apparatus, but failed to limit or differentiate the claimed structure from any apparatus comprising a processor and a memory.

**Claim 28:**

The combination Strietzel/Treyz discloses the limitations as shown in the rejection above. Further, Streitzel, as shown, discloses the following limitation:

- *forward said promotion message to one or more other apparatuses* (see at least ¶0081, forwarding a promotion message).

**Claim 30:**

The combination Strietzel/Treyz discloses the limitations as shown in the rejection above.

Further, Strietzel, as shown, discloses the following limitation:

- *causing, at least in part, forwarding said promotion message to one or more other communication terminals* (see at least ¶0081, forwarding a promotion message).

**Response to Arguments**

8. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new grounds of rejection.
9. Applicant primarily contends that the content of the promotion message, an invitation for a reminder for an event with a defined start time, is functional material because reminders may be sent based on the defined start time. As noted above, the content of the message as claimed is not functional and does not carry patentable weight. Although in other limitations that require sending a message based on a time, the time is functional, the fact that the same time is earlier displayed in a promotional message does not make the content of the promotional message functional. Examiner provided a new reference in the above rejection that teaches more directly the specified (although not particularly claimed) invention in an effort to advance prosecution.
10. Examiner again notes that throughout Applicant's remarks, Applicant refers to the invention disclosed in the current application as 'the inventions' (see at least page 14). Examiner previously interpreted the various claims and claims sets as defining as single invention. If Examiner is mistaken, and Applicant believes that the present application is directed to more than one invention, Applicant is encouraged to contact Examiner to discuss that issue. Particularly, Examiner now recognizes that Applicant has claimed several "apparatus" devices each with different functions (sending vs. receiving). Although the functions do not differentiate the several

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apparatus claims as noted above, and Examiner maintains Examiner's interpretation that the apparatus claims define the same apparatus, Examiner now recognizes that Applicant may intend to claim several different devices in the same application. Should Applicant's subsequent amendments serve to structurally distinguish the several apparatus claims, Examiner may require a restriction to limit the content of this application to a single invention because Applicant is only entitled to claim a single invention per patent application. Examiner encourages Applicant to address this matter; Applicant overlooked this issue in Applicant's current response.

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### **Conclusion**

11. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 8:30am-4:00pm EST. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.
12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
13. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**P.O. Box 1450, Alexandria, VA 22313-1450**

or faxed to **571-273-8300**.

14. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Randolph Building

401 Dulany Street

Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 3622  
27 August 2010

/Arthur Duran/  
Primary Examiner, Art Unit 3622